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#8

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

1033 U.S. PTO  
09/803173  
03/09/01

In re Application of: )  
Cheng, Chong Seng )  
Serial No.: To be assigned )  
Filing Date: March 9, 2001 )  
(even date herewith) )  
For: A Portable Data Storage Device Capable )  
Of Being Directly Connected Via USB )  
Plug To A Computer (as amended) )

03/29/2001 BABRAHA1 00000002 09803173  
01 FC:122 130.00 OP

A Continuation Application of: )  
Trek Technology (Singapore) Pte Ltd )  
Inventor: Cheng, Chong Seng )  
International Application No.: PCT/SG00/00029 )  
International Filing Date: February 21, 2000 )  
For: A Portable Data Storage Device )

**PETITION TO MAKE SPECIAL**  
**BECAUSE OF ACTUAL INFRINGEMENT**  
**UNDER 37 CFR §1.102 AND MPEP §708.02**

Assistant Commissioner for Patents  
Washington, D.C. 20231

RECEIVED  
APR 16 2001  
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Dear Sir:

1. PETITION: Applicant hereby petitions that the above-captioned application, filed concurrently herewith, be made special because of actual infringement. This application has not yet received any examination.

## 2. CLAIMS

A portable data storage device covered by one or more of the pending claims in the above-captioned application is currently being manufactured and marketed by M-Systems, Inc. of Kfar Saba, Israel under the tradename "DiskOnKey". M-Systems, Inc. maintains a place of business at Newark, California and is one of Trek Technology's competitors. As evidenced by Exhibit A, the DiskOnKey product is at least being offered for sale in the United States.

Another portable data storage device covered by one or more of the pending claims in the above-captioned application is also currently being manufactured and marketed by ei Corporation, a subsidiary of Agate Technologies, Inc. of Milpitas, California under the tradename "Q drive" and is one of Trek Technology's competitors. As evidenced by Exhibit B, the Q drive is at least being offered for sale in the United States.

Accompanying this petition is evidence of infringement alleged herein:

(a) Exhibit A is a printed copy of the marketing and product information posted on M-Systems' company web site showing the features of a portable data storage device that infringes one or more of the pending claims. This exhibit has been printed from M-Systems' company web site at <http://www.m-sys.com> on February 6, 2001.

(b) Exhibit B is a printed copy of the marketing and product information posted on Agate Technologies' company web site showing the features of a portable data storage device that infringes one or more of the pending claims. This exhibit has been printed from Agate Technologies' company web site at <http://www.agatetech.com> on February 6, 2001.

(c) Exhibit C is a Statement of Facts in Support of Petition to Make Special Because of Actual Infringement by Cheng Chong Seng, the inventor of the invention claimed in the above-captioned application, confirming that the invention is infringed and indicating the date of discovery of the infringement.

(d) Exhibit D is a Statement by Attorney in Support of Petition to Make Special Because of Actual Infringement by Warren S. Heit, the undersigned attorney, confirming that at least some of the pending claims are unquestionably infringed by the M-Systems product and/or Agate product shown and described in Exhibits A and B, respectively.

3. SEARCH

The undersigned attorney has caused to be made a search of the pertinent prior art on or about November 28, 2000. Twelve (12) references that may be material to the patentability of the pending claims have been identified as a result of the search. All such references are provided to the Examiner as being filed in a respective Information Disclosure Statement.

4. COPIES OF REFERENCES

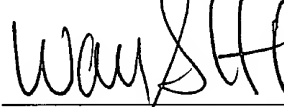
As stated above, the twelve (12) references identified in the prior art search are provided to the Examiner as being filed in a respective Information Disclosure Statement.

5. FEES

A check in the amount of the \$130.00 petition fee set forth in 37 CFR §1.17(i) is enclosed. Please charge any additional fees or apply any credits to our PTO deposit account number: 23-1703.

Dated: March 9, 2001

Respectfully submitted,  
WHITE & CASE LLP



Warren S. Heit      Reg. No. 36,828 —  
WHITE & CASE LLP  
1155 Avenue of the Americas  
New York, New York 10036  
(650) 213-0321

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:	)	
	)	
Cheng, Chong Seng	)	Examiner: To be determined
	)	
Serial No.: To be determined	)	Art Unit: To be determined
	)	
Filing Date: March 9, 2001	)	White & Case Attorney
(even date herewith)	)	Docket No.: 1601457-0004
	)	
For: A Portable Data Storage Device Capable	)	
Of Being Directly Connected Via USB	)	
Plug To A Computer (as amended)	)	
	)	
A Continuation Application of:	)	
	)	
Trek Technology (Singapore) Pte Ltd	)	
	)	
Inventor: Cheng, Chong Seng	)	
	)	
International Application No.: PCT/SG00/00029	)	
	)	
International Filing Date: February 21, 2000	)	
	)	
For: A Portable Data Storage Device	)	
	)	

**STATEMENT OF FACTS IN SUPPORT OF**  
**PETITION TO MAKE SPECIAL BECAUSE OF ACTUAL INFRINGEMENT**  
**UNDER 37 CFR §1.102 AND MPEP §708.02**

Assistant Commissioner for Patents  
Washington, D.C. 20231

Dear Sir:

I, Cheng Chong Seng, having my office at Trek Technology (Singapore) Pte Ltd, 30  
Loyang Way #07-13/14/15, Loyang Industrial Estate, Singapore 508769, am the inventor of

Exhibit C

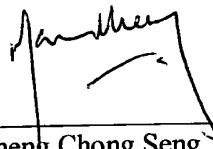
invention claimed in the above-captioned application, filed concurrently herewith, and I hereby state the following:

1. There is an actual infringement of this invention.
2. The Q drive product that I allege infringes this invention was first discovered on or about October 13, 2000, when I was notified by a distributor about the availability of the Q drive product on the market. I visited the company web site of Agate Technologies, Inc. on or about October 13, 2000 to verify that the Q drive product was being marketed by Agate Technologies, through its subsidiary ei Corporation, in the United States.
3. The DiskOnKey product that I allege infringes this invention was first discovered on or about November 8, 2000, when I was notified by a distributor about the availability of the DiskOnKey product on the market. I visited the company web site of M-Systems, Inc. on or about November 8, 2000 to verify that the DiskOnKey product was being marketed by M-Systems in the United States.

I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code and that such willful false statements may jeopardize the validity of the application or any patent issued thereon.

Respectfully submitted,

Dated: February 12, 2001

  
\_\_\_\_\_  
Cheng Chong Seng

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:	)	
	)	
Cheng, Chong Seng	)	Examiner: To be assigned
	)	
Serial No.: To be assigned	)	Art Unit: To be assigned
	)	
Filing Date: March 9, 2001	)	White & Case Attorney
(even date herewith)	)	Docket No.: 1601457-0004
	)	
For: A Portable Data Storage Device Capable	)	
Of Being Directly Connected Via USB	)	
<u>Plug To A Computer (as amended)</u>	)	
	)	
A Continuation Application of:	)	
	)	
Trek Technology (Singapore) Pte Ltd	)	
	)	
Inventor: Cheng, Chong Seng	)	
	)	
International Application No.: PCT/SG00/00029	)	
	)	
International Filing Date: February 21, 2000	)	
	)	
For: A Portable Data Storage Device	)	
<u></u>	)	

**STATEMENT IN SUPPORT OF**  
**PETITION TO MAKE SPECIAL BECAUSE OF ACTUAL INFRINGEMENT**  
**UNDER 37 CFR §1.102 AND MPEP §708.02**

Assistant Commissioner for Patents  
Washington, D.C. 20231

Dear Sir:

I, Warren S. Heit, having my office at White & Case LLP, 3000 El Camino Real, 5 Palo Alto Square, 10<sup>th</sup> Floor, Palo Alto, California 94306, am the attorney of record in the above-captioned application, filed concurrently herewith, and I hereby state the following:

Exhibit D

1. I have made a rigid comparison of the alleged infringing product referred to in the accompanying Statement of Facts in Support of Petition to Make Special Because of Actual Infringement with the claims of this application.

2. In my opinion, at least claim 9 on file in this application is unquestionably infringed, as illustrated in the following claim chart.

<b>Claim 9</b>	<b>Features of M-Systems' DiskOnKey product</b>	<b>Features of ei Corporation's Q drive product</b>
A portable data storage device comprising:		
a USB plug adapted to the device to facilitate direct coupling of the USB plug to a USB socket on a computer without wire interconnection;	The DiskOnKey product is a removable storage device having a USB interface for coupling to a USB port without a wire. (Exhibit A, p. 1; note figure)	The Q drive is a USB storage device that plugs into a USB port without a wire or cable. (Exhibit B, p. 1; note figure; see also p. 3)
a memory device including non-volatile solid-state memory; and	The DiskOnKey product includes non-volatile flash memory. (Based on information and belief)	The Q drive uses non-volatile flash memory. (Exhibit B, p. 1)
a memory control device coupled to the memory device for controlling data flow between the memory device and the USB plug.	The DiskOnKey product has its own CPU. (Exhibit A, p. 1)	The Q drive requires a memory control device for controlling data flow. (Based on information and belief)

3. I have caused to be made a search of the pertinent prior art. All such material art is provided to the Examiner as being filed in a respective Information Disclosure Statement.

4. I believe all the claims in this application as on file resulting from the concurrently filed preliminary amendment are allowable.

I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code and that



such willful false statements may jeopardize the validity of the application or any patent issued thereon.

Dated: March 9, 2001

Respectfully submitted,

WHITE & CASE LLP



Warren S. Heit

Reg. No. 36,828

WHITE & CASE LLP

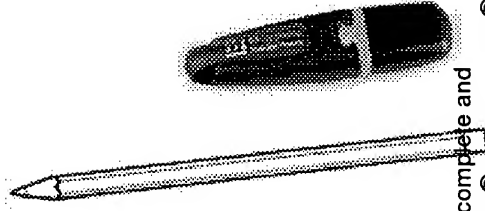
1155 Avenue of the Americas

New York, New York 10036

(650) 213-0321

## DiskOnKey

- Removable storage with capacities of 8, 16 and 32 MB
- USB Interface
- Fully Plug & Play, no driver installation required
- Appears as a Hard Disk in the system
- Data security
- M-Systems' TrueFFS<sup>®</sup> technology
- Optimal data retention
- Failure resistant
- No power supply or batteries needed
- Reliable, pocketable, personal, portable storage



## Overview

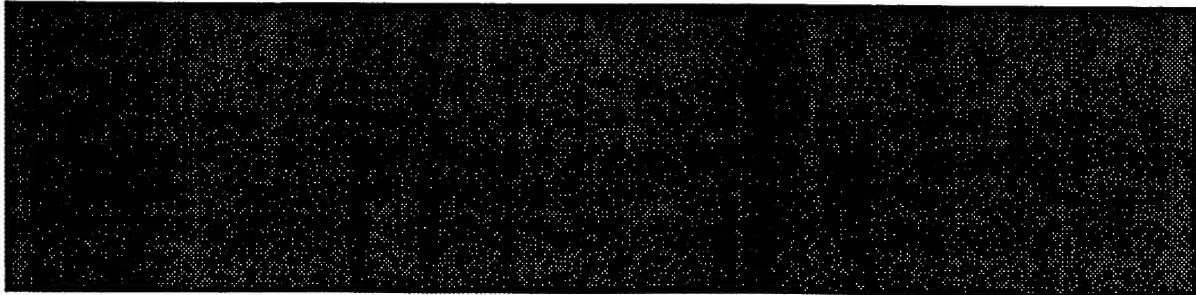
The DiskOnKey utilizes a standard Universal Serial Bus (USB) port for complete and instantaneous plug-n-play interoperability on the latest Windows<sup>®</sup>, Mac<sup>®</sup> OS and Linux<sup>®</sup> operating systems - without requiring users to load software drivers<sup>(1)</sup>. When plugged into an USB port, the DiskOnKey operates as a secure, reliable, removable hard drive.

## Capabilities and Opportunities

The DiskOnKey lends itself to a wide variety of innovative uses. The product is an active device with its own central processing unit (CPU) and is capable of supporting and running multiple applications directly from the product. When using the DiskOnKey you can save documents, presentations, cross the boundaries between a PC & Macintosh, and save downloaded music, videos or books. Because it connects with host computers through a USB port, the DiskOnKey product is easily utilized; just plug it in! The host computer will immediately detect it and recognize it as a supplementary hard drive.

## DiskOnKey Specifications

### DiskOnKey host interface Universal Serial Bus (USB)



**Power supply**

USB Bus-powered  
No external power required

**Power Consumption**

Standby: 30  $\mu$ A (typical), 500  $\mu$ A (Max)  
Read/Write: 80 mA (typical), 95 mA (Max)

**Performance (read/write)**

Up to 12 MBits/sec

**Supported Operating Systems**

Windows 98<sup>(1)</sup>, Windows 2000, Windows Me, MacOS 8.6, Linux 2.4.0

**Capacity**

8 MB, 16 MB and 32 MB

**LED Indication**

LED beeping slowly:  
DiskOnKey connected and inactive  
LED in fast flashing mode:  
Transmitting/receiving data

**Operating Temperature**

0 °C to +45 °C

**Storage Temperature**

-20 °C to +60 °C

**Environmental Conditions**

Relative humidity during operation (Non-condensation): 10% to 90%  
Relative humidity during storage: 5% to 90%  
Maximum wet bulb temperature: +38.7 °C (101.6 °F)

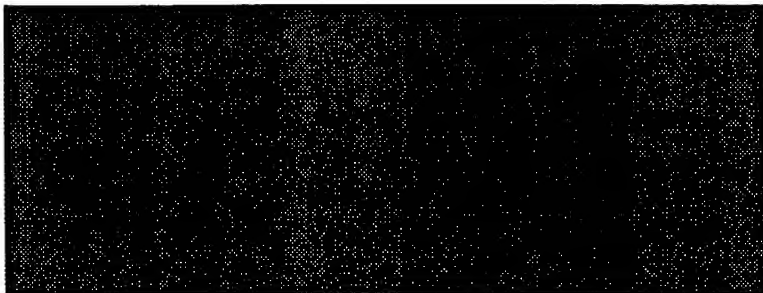
**Dimensions**

Length: 82 mm  
Width: 15 mm  
Height: 23 mm

**Vibration**

Operating: 0.5 G, 10 to 500 Hz, 0.5 Oct/Min sweep rate  
Non-operating: 1.0 G, 10 to 500 Hz, 0.5 Oct/Min sweep rate

**Shock**



Operating: 10 G, 11 ms, half-sine

**Maximum Altitude**

Operating: 3,048 m (0 to 10,000 ft.) (14.7 to 10.1 PSIA)

Non-operating: 9,144 m (0 to 30,000 ft.) (14.7 to 4.4 PSIA)

(1) Click here to download the DiskOnKey driver for Windows 98.

[Click here to get your DiskOnKey !](#)


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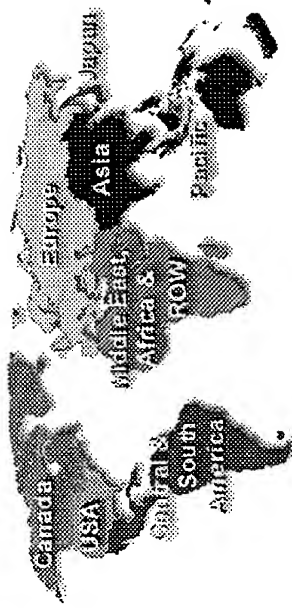
## Contact Information

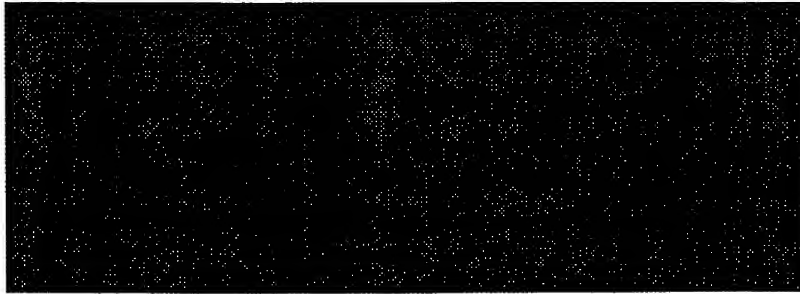
### Offices

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Newark, CA 94560  
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Fax: 510-494-5545  
info@m-sys.com

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Tokyo, 141-0031  
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Fax: +81-3-5437-5759

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Fax: +886-2-8770-6295  
asia@m-sys.com

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Tel: 972-9-764-4992  
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Europe@m-sys.com

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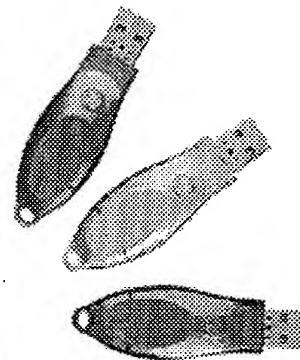


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DESKTOPS



ProSwap

## Q. - USB Hard Drives



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- Brandon Hymas  
Real Business Solutions



## Q. - USB Hard Drives

**Accessing  
and  
Transporting  
Data Has  
Never Been  
Easier!**

Q is a USB storage device that makes transporting your data incredibly easy. Just plug Q into any USB port and it will show up as another hard drive. Now you can move, store, or delete data effortlessly. This ingenious storage device is so versatile you can run applications, view videos, or play MP3 files directly from it. Q comes in various storage capacities of 16, 32, and 64mb. Q uses non-volatile flash memory so you can safely store and transport your valuable data. The 16mb USB Q "hard drive" stores

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up to 10 times  
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**Press Release**

Shirley Ooi  
Agate Technologies Inc  
(408) 956-7950  
sooi@agatetech.com

ei Corporation -- an Agate Company Announces "Q"

MILPITAS, Calif., Sep 26, 2000 -- ei Corporation, an Agate company AGTE introduced today, a new and improved USB digital storage device. Designed with an attachable ring, Q meets the needs of today's mobile users. With Q your data is both mobile and wearable. Approximately the size of a key, Q drive has an extended OS compatibility with Windows 98/SE/ME and will, in the near future, function with MacOS and Linux Solaris.

ei Corporation is working towards adding various other applications and enhanced features on the Q drive, such as software application downloads to access your data connecting to other computers in one compact "hard drive." Q has various storage sizes ranging from 16MB to 128MB -- up to 10 times (at 16MB) the storage capacity of a standard 3.5" floppy disk.

By plugging into the USB port, Q will show up on your desktop screen, ready for use as a removable drive, with no cables or extra storage disks required. Additionally, Q functions on virtually any application, and because Q is a flash memory storage device, it is less sensitive to shock or damage than a hard drive.

"With USB as the de-facto connector on all modern PCs," said Mr. Yong Thye Lin, Chief Executive Officer for ei. "Introducing a USB-enabled storage device, Q will open future storage capability to new heights in accessing data virtually anywhere."

ei Corporation, an Agate company, is expected to release Q drive for retail by late October 2000. Q drive storage capacity variations are 16, 32, 64 and 128 MB with list prices starting at USD\$69.95.

\*A device installation disk is provided in the Q drive package.